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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,807	11/10/2003	Kenichi Hayashi	81868.0109	5415
26021	7590	10/04/2006		
HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER RIVERO, MINERVA	
			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,807

Applicant(s)

HAYASHI ET AL.

Examiner

Minerva Rivero

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11, 14-15 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S.

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Patent No. 7,027,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims include all of the limitations of the instant application claims, respectively. The patent claims also include additional limitations. Hence, the instant application claims are generic to the species of invention covered by the respective patent claims. As such, the instant application claims are anticipated by the patent claims and are therefore not patentably distinct therefrom. (See *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2D 1869, "a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim", *In re Goodman*, 29 USPQ2d 2010, "Thus, the generic invention is 'anticipated' by the species of the patented invention" and the instant "application claims are generic to species of invention covered by the patent claim, and since without terminal disclaimer, extant species claims preclude issuance of generic application claims").

4. Claims 12-13, and 16-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. <sup>7027377</sup> ~~7~~, in view of Saito *et al.* (US 6,636,365), hereinafter Saito.

5. Regarding claim 12, Saito discloses a boundary portion between the center side of the refraction surface region and the peripheral side refraction surface region is located at a position corresponding to a Numerical Aperture (NA) ranging from 0.45 to 0.55 (Col. 14, Lines 28-30).

Therefore it would have been obvious to one ordinarily skilled in the art at the time of the invention to have a boundary portion between the center side of the refraction surface region and the peripheral side refraction surface region is located at a position corresponding to a Numerical Aperture (NA) ranging from 0.45 to 0.55, as disclosed by Saito, in order to have an optical pickup apparatus be compatible with CD and DVD media.

6. Regarding claim 13, Saito discloses the common objective lens is a convex lens (Col. 18, Lines 5-8).

Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to have a common lens be a convex lens, as disclosed by Saito since it is a common practice in the art.

7. Regarding claims 16 and 17, Saito discloses the incident refractive side has a positive power (Col. 18, Lines 5-8).

Therefore it would be obvious to one ordinarily skilled in the art at the time of the invention to have an incident refractive side have a positive power, as disclosed by Saito, in order to magnify a light beam incident upon it as opposed to diminishing it.

8. Regarding claims 18 and 19, Saito discloses the first optical wavelength is 780 nm, and the second optical wavelength is 650 nm (Col 1, Lines 29-32 and 43-45).

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Therefore it would be obvious to one ordinarily skilled in the art at the time of the invention to have a first optical wavelength be 780 nm, and a second optical wavelength be 650 nm, as disclosed by Saito, in order to effectively reproduce both CD and DVD media.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takasawa *et al.* (US 6,016,301) disclose an optical pickup device with interchangeability between CDs and DVDs.

Yamamoto *et al.* (US 6,570,827) disclose an optical element for correction of chromatic aberration.

Maruyama *et al.* (US 6,624,942) disclose an objective lens for an optical pickup.

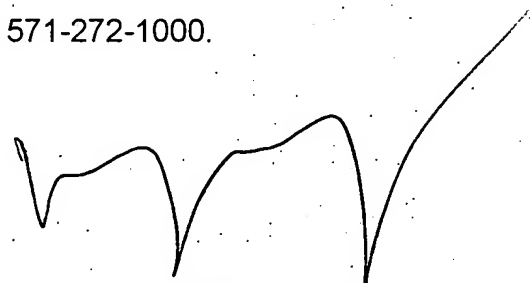
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minerva Rivero whose telephone number is (571) 272-7626. The examiner can normally be reached on Monday-Friday 9:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR 10/01/06



WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER